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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,974	08/28/2001	Wayne Lewis Dickerson JR.	END920010076US1	6358
23550	7590	08/25/2005	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			STIMPAK, JOHNNA	
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ALBANY, NY 12207			3623	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/940,974

Applicant(s)

DICKERSON, WAYNE LEWIS

Examiner

Johnna R. Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/28/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The following is a first office action upon examination of application number 09/940,974.

Claims 1-22 are pending and have been examined on the merits discussed below.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 8/28/01 has been considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 recites the limitation "information system" in line 1 of claims 21 on page 26.

There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC §101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

6. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, the recited steps of identifying metrics, assembling solutions, assessing impacts of solutions, comparing performance to expose performance gaps and identifying a solution based on impacts to address performance gaps do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to find a solution to improve a business value of a company.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a solution based upon impacts of solutions to address exposed performance gaps (useful, tangible and concrete).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-10 are deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1-4, 6-8, and 11-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Machin et al, US 6,877,034.

As per claim 1, Machin et al teaches identifying operational metrics for the industry (figs. 12 and 13 – a set of metrics are identified to evaluate a call center); assembling a set of solutions for the industry (column 12, lines 17-30 – a set of potential solutions are identifies for each metric); assessing impacts of the solutions on operational metrics (column 12, lines 17-30 – the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap); comparing current operational performance of the company to an operational performance of another company within the industry to expose performance gaps (column 11, line 15 – column 12, line 15 – a

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performance gap analysis is performed evaluating the performance gap between the requesting user and a peer group); and identifying a solution based upon the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also - for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on investment to implement – that with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)).

As per claim 2, Machin et al teaches the identifying step comprises the step of generating a value proposition by identifying a solution based on the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also – for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on investment to implement – that with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)).

As per claim 3, Machin et al teaches the identified solution improves a business value of the company (column 13, lines 28-35 – the targeted benchmarking set forth enhances management decision making abilities in selecting the best improvement initiatives thereby improving performance in key areas).

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As per claim 4, Machin et al teaches the operational metrics relate to viability of a company in the industry (fig. 12 and 13 and column 6, lines 40-67 – each of the metrics used to measure performance inherently related to the success or effectiveness of a company).

As per claim 6, Machin et al teaches identifying operational metrics for the industry (figs. 12 and 13 – a set of metrics are identified to evaluate a call center); assembling a set of solutions for the industry (column 12, lines 17-30 – a set of potential solutions are identifies for each metric); assessing impacts of the solutions on operational metrics (column 12, lines 17-30 – the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap); comparing current operational performance of the company to an average operational performance of companies within the industry to expose performance gaps (column 7, lines 15-25 – when the peer group is specified and example is given that it might consist of all call centers handling mostly inbound calls, etc., inherently the average performance of the multiple call centers in the peer group would used for comparison purposes; column 11, line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the performance gap between the requesting user and a peer group); and identifying a solution based upon the impacts to address the exposed performance gaps (column 12, lines 17-30 - the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also - for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on

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investment to implement – that with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)).

As per claim 7, Machin et al teaches the identified solution improves a business value of the company (column 13, lines 28-35 – the targeted benchmarking set forth enhances management decision making abilities in selecting the best improvement initiatives thereby improving performance in key areas).

As per claim 8, Machin et al teaches the operational metrics relate to viability of a company in the industry (fig. 12 and 13 and column 6, lines 40-67 – each of the metrics used to measure performance inherently related to the success or effectiveness of a company).

Claims 11-13 are directed to the system for performing the method of claims 1, 3 and 4. Therefore, since Machin et al teaches a computer system, the same rejections as applied to claims 1, 3 and 4 are applied to claims 11-13.

As per claim 14, Machin et al teaches the system further receives operational performance data of the company and average operational performance data of the companies within the industry (column 6, lines 40-67 – performance data of the company is collected using a survey; column 7, lines 15-25 – when the peer group is specified and example is given that it might consist of all call centers handling mostly inbound calls, etc., inherently the average performance of the multiple call centers in the peer group would be used for comparison purposes).

Claims 15-17 are directed to the system for performing the method of claims 6-8. Therefore, since Machin et al teaches a computer system, the same rejections as applied to claims 6-8 are applied to claims 15-17.



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Claims 18-20 are directed to the program product stored on a recordable medium for performing the method of claims 1, 3 and 4. Therefore, since Machin et al teaches a computer system, the same rejections as applied to claims 1, 3 and 4 are applied to claims 11-13.

As per claim 21, Machin et al teaches receiving operational performance data of the company and average operational performance data of the companies within the industry (column 6, lines 40-67 – performance data of the company is collected using a survey; column 7, lines 15-25 – when the peer group is specified and example is given that it might consist of all call centers handling mostly inbound calls, etc., inherently the average performance of the multiple call centers in the peer group would be used for comparison purposes).

Claim 22 is directed to the program product stored on a recordable medium for performing the method of claim 6. Therefore, since Machin et al teaches a computer system, the same rejection as applied to claim 6 is applied to claim 22.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Machin et al, US 6,877,034.

As per claim 5, Machin et al does not explicitly teach the comparing step is performed after the assessing step, however, it is old and well known in the art of performance management

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to assess solutions to improve upon the metrics to determine the if the solution would benefit or hurt the metric. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the assessment of the solutions prior to comparing against performance of other companies so the company would know which areas could benefit most from the solutions and/or which solutions would most likely need to be implemented. This would give the company a thorough view of potential solutions that would improve the overall performance of the company.

As per claim 9, Machin et al does not explicitly teaches the comparing step is performed after the assessing step, however, it is old and well known in the art of performance management to assess solutions to improve upon the metrics to determine the if the solution would benefit or hurt the metric. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the assessment of the solutions prior to comparing against performance of other companies so the company would know which areas could benefit most from the solutions and/or which solutions would most likely need to be implemented. This would give the company a thorough view of potential solutions that would improve the overall performance of the company.

As per claim 10, Machin et al teaches identifying operational metrics for the industry (figs. 12 and 13 – a set of metrics are identified to evaluate a call center); assembling a set of solutions for the industry (column 12, lines 17-30 – a set of potential solutions are identifies for each metric); assessing impacts of the solutions on operational metrics (column 12, lines 17-30 – the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap); comparing

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current operational performance of the company to an average operational performance of companies within the industry to expose performance gaps (column 7, lines 15-25 – when the peer group is specified and example is given that it might consist of all call centers handling mostly inbound calls, etc., inherently the average performance of the multiple call centers in the peer group would be used for comparison purposes; column 11, line 15 – column 12, line 15 – a performance gap analysis is performed evaluating the performance gap between the requesting user and a peer group); and generating a value proposition by identifying a solution based on the impacts to address the exposed performance gaps (column 12, lines 17-30 – the gap versus solution optimizer report takes each metric and comes up with a summary of potential solutions; then estimates the impact of the solution on the performance gap and ranks the solutions in descending order with the best solution at the top; see fig 14 also – for each performance gap, based on the metrics, an optimal decision index is calculated based on cost to implement, time to implement, risk to implement and return on investment to implement – that with the lowest optimal decision index is the best proposed solution for that performance gap (column 13, lines 22-27)). Machin et al does not explicitly teach the comparing step occurring after the assessing step. However, it is old and well known in the art of performance management to assess solutions to improve upon the metrics to determine if the solution would benefit or hurt the metric. It would have been obvious to one of ordinary skill in the art at the time of the invention to perform the assessment of the solutions prior to comparing against performance of other companies so the company would know which areas could benefit most from the solutions and/or which solutions would most likely need to be implemented. This would give the

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company a thorough view of potential solutions that would improve the overall performance of the company.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Harhen, US 5,406,477 – multiple reasoning and result reconciliation for enterprise analysis

Couchot et al, US 6,850,866 – managing performance metrics describing a relationship between a provider and a client

Eder, US 6,321,205 – method of and system for modeling and analyzing business improvement programs

Hill et al, US 2002/0091817 – performance measurement system and method

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736.

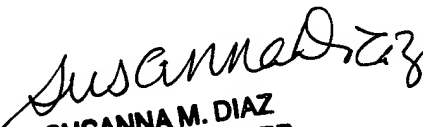
The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS  
8/22/05

  
**SUSANNA M. DIAZ**  
**PRIMARY EXAMINER**  
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